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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,268	11/26/2003	John Nohl	60130-1968 / 04MRA0070	8863
26096	7590	01/03/2005	EXAMINER	
CARLSON, GASKEY & OLDS, P.C. 400 WEST MAPLE ROAD SUITE 350 BIRMINGHAM, MI 48009			TRAN, DIEM T	
			ART UNIT	PAPER NUMBER
			3748	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/724,268

Applicant(s)

NOHL ET AL.

Examiner

Diem Tran

Art Unit

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 14-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

This office action is in response to the amendment filed on 10/12/04. In this amendment, claims 1, 5, 14, 15, 17, 20-22 have been amended; claims 10-13 have been canceled and claims 23-26 have been added. Overall, claims 1-9, 14-26 are pending in this application. The Applicant's arguments have been considered and are deemed persuasive; however, a new non-final rejection is set forth below.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 26 of the amendment filed on 10/12/04, the applicants added the claimed limitation "*said valve neck includes a hollow tube*" is considered new matter since the originally filed disclosure does not contain any support for the invention as now claimed.

The amendment filed 10/12/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: *said valve neck includes a hollow tube*.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claims 1-9, 14-20, 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Welge (US Patent 2,753,147).***

Regarding claims 1, 14, Welge discloses an exhaust valve assembly comprising:  
a valve plate (21) movable within an exhaust pipe between an open and closed position, and an electric actuator (47) for moving said valve plate (see Figure 1).

Regarding claims 2, 15, Welge further discloses a valve neck for supporting said electric actuator (47) a distance from said exhaust pipe (see Figures 1, 2).

Regarding claims 3, 4, 17, Welge further discloses a support housing supported by said valve neck, said support housing comprising a plate disposed between said electric actuator (47) and said exhaust pipe for shielding said actuator from heat (see Figure 1).

Regarding claims 5, 6, 16, 25, Welge further discloses that said valve neck comprises a tubular cross section having a first mount adjacent a first end for attachment to an exhaust pipe and a second mount adjacent a second end opposite said first end for supporting said support housing (see Figures 1, 2).

Regarding claims 7, 8, Welge further discloses that said electric actuator (47) comprises a linearly and a rotatably movable element (see Figures 1, 2).

Regarding claims 9, 18, Welge further discloses an actuation tube (24) having a tubular cross section rotatable by said electric actuator (47) for moving said valve plate (21) (see Figure 1).

Regarding claim 19, Welge further discloses that said valve plate (21) creates a tuning effect replicating an exhaust pipe of a diameter smaller than said exhaust pipe (see Figure 1).

Regarding claim 20, Welge further discloses that an actuation tube (24) having a solid shaft (see Figures 1, 2).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welge (US Patent 2,753,147) in view of Stark (US Patent 4,373,330).***

Regarding claims 21, 22, Welge discloses all the claimed limitations as discussed in claim 14 above, however, fails to disclose the actuation tube having a hollow shaft. Stark teaches that it is conventional in the art, to utilize an actuation tube being a hollow shaft (see col. 4, lines 53-57).

It would have been obvious to one having ordinary skill in the art, to have utilized the teaching of Stark in the device of Welge, since the use thereof would have reduced weight of the valve.

*Claims 23, 24, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welge (US Patent 2,753,147).*

Regarding claims 23, 24, Welge discloses all the claimed limitations as discussed in claims 1, 14, respectively, above, however, fails to disclose that said electric actuator includes a first pull coil for initiating movement of the valve plate and a second hold coil for holding said valve plate in a desired position.

It is well known to those with ordinary skill in the art that an electric actuator includes a first pull coil for initiating movement of the valve plate and a second hold coil for holding said valve plate in a desired position to control constant flow of the exhaust gas through the pipe. Therefore, such disclosure by Welge is notoriously well known in the art so as to be proper for official notice.

Regarding claim 26, Jacque discloses all the claimed limitations as discussed in claim 15 above, Welge further discloses said valve neck has a first and second mount for attachment to said exhaust pipe and for supporting said electric actuator (see Figure 1); however, fails to disclose that said valve neck includes a hollow tube.

With regard to the limitation directed to the shape of valve neck, it is the examiners position that a valve neck having hollow portion would have been an obvious matter of design choice well within the level of ordinary skill in the art, since it has been held that a change in the shape of the element involves only routine skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966).

***Response to Arguments***

Applicant's arguments filed on 10/12/04 have been considered but they are moot in view of a new ground(s) of rejection.

**Conclusion**

Any inquiry concerning this communication from the examiner should be directed to Examiner Diem Tran whose telephone number is (571) 272-4866. The examiner can normally be reached on Monday -Friday from 8:00 a.m.- 5:30p.m.

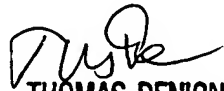
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion, can be reached on (571) 272-4859. The fax number for this group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-786-9199 (toll-free).



Diem Tran  
Patent Examiner  
Art unit 3748

DT  
December 21, 2004



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